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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,959	03/04/2002	Robert Levin	99-0002	7019

7590 08/26/2003

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St. Peters, MO 63376

EXAMINER
PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
3711	5

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/092,959	LEVIN, ROBERT	
	Examiner	Art Unit	
	William M Pierce	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 June 2003* .

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 5 and 10, "the common wording", in claims 3, 4, 6, 7 and 9, "the category", in claims 4 and 8, "the amount of help provided" and in claim 9, "the progress" lack a proper antecedent. With the amendment to the claims 1, 5 and 10, applicant has added significant physical steps to the claims such as "providing" which are usually indicative of a method claim. As a result, whether the claims are being drawn to a method or an apparatus is cloudy. Applicant is asked to positively recite in the preamble of the claim whether they are drawn to an apparatus or a method in order to overcome this portion of the rejection.

Claim Rejections - 35 USC § 103

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rein as set forth in the previous office action and below in response to applicant's remarks.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlegel as set forth in the previous office action and below in response to applicant's remarks.

Response to Arguments

Applicant's arguments filed 6/17/03 have been fully considered but they are not persuasive.

In the previous office action, the examiner set forth that the specification set forth that the "breadth" of what is meant by a "sesquipedalian" is as broad as a "thing" from pg. 1, lns. 15-17. Well known is that Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). In response to this, applicant appears to argue that his claimed invention distinguishes over the applied art since the its "common dictionary definition" provides the narrowing of the scope of the patent. However, it is impermissible for one to read such things into the claims. Limitations appearing in the specification or elsewhere but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed....

An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.") and Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571-72, 7 USPQ2d 1057, 1064-1065 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988) (Various limitations on which appellant relied were not stated in the claims; the specification did not provide evidence indicating these limitations must be read into the claims to give meaning to the disputed terms.)

Additionally, applicant's argues that his game is a "specific type" of game. However, the examiner is not persuaded by this argument since a "type" of game is only different from the applied art based on the indicia used to pose a question to a player and in the meaning conveyed thereby. This is analogous to a change in "theme" of a game, which has been held to be a non-patentable advance. In In re Gulack, 703 F.d. 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), the court concluded that the claimed printed matter, in this case a question in the form of a sesquipedalian, should be given patentable weight when there exists a functional relationship between the printed matter and the substrate. By contrast, in the present case, there is no functional relationship between the substrate (the type of question, display area and cards as recited in claims 1, 5 and 10 respectively) and the means used for indicating or posing a question. The game and card substrates merely serve the same purpose of posing a question for a player to attempt to correctly answer as in the games of the applied art to Rein and Schlegel. There is no evidence of record that using the theme of "sesquipedalian" in posing the question to a player solves any particular problem or produces any unexpected results other than those known in the prior art. Specifically, ad in the prior art, player is presented with a stimulus that test whether or not he has the ability to provide the correct answer. Whether on chooses a theme of movies, long words, abbreviations, acronyms, sesquipedalian or the like, nothing is being added to what is known in the art to basic question and answer type games. While the examiner cannot disagree that the recitation of a sesquipedalian and its "common dictionary definition" narrow the scope of the claimed invention, the question here is one of obviousness.

While the examiner has rejected the claims over Rein as being shown based on the breadth of the meaning of the term sesquipedalian as defined in the specification, in line with the above rational under a question of obviousness, Rein presents a problem to be solved to a player and the player attempts to respond with a correct answer. The change of theme by using a question in the form of a sesquipedalian is not a patentable advance sins there exists no new and non-obvious functional relationship to the substrate. The question and answer games of

Rein and the instant invent function the same and only differ in the design of the question that is posed to a player. This position by the examiner was also taken with respect to Schlegel when applied to the claims rejected.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.

Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is Customerservice3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

WILLIAM M. PIERCE
PRIMARY EXAMINER